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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/924,760	08/08/2001	Allisa Gam	FA0992 US NA	4339

23906 7590 02/20/2004

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WILMINGTON, DE 19805

EXAMINER

SHOSHO, CALLIE E

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 02/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/924,760

**Applicant(s)**

GAM, ALLISA

**Examiner**

Callie E. Shosho

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10/24/03 & 12/12/03.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.  
4a) Of the above claim(s) 11 and 12 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-10 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

1. All outstanding rejections except for those described below are overcome by applicant's amendment and arguments filed 10/24/03 and 12/12/03.

**Election/Restrictions**

2. Applicant's election of Group I, claims 1-10, in the paper filed 10/24/03 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

3. Claims 11-12 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the paper filed 10/24/03.

**Claim Rejections - 35 USC § 102**

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Honel et al. (U.S. 5,055,542).

The rejection is adequately set forth in paragraph 8 of the office action mailed 4/23/03 and is incorporated here by reference.

6. Claims 1-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Klein et al. (U.S. 6,268,409).

The rejection is adequately set forth in paragraph 9 of the office action mailed 4/23/03 and is incorporated here by reference.

#### **Response to Arguments**

7. Applicant's amendment and arguments filed 10/24/03 and 12/12/03 have been fully considered but they are not persuasive.

Specifically, applicant argues that Honel et al. is not applicable against the present claims given that all the present claims now recite "consisting essentially of" transitional language and given that Honel et al. requires that the dispersant is formed from urethane, which is outside the scope of the present claims.

However, it is noted that the use of isocyanate in the reaction product used to form the dispersant and thus, production of dispersant containing urethane, is not required in Honel et al. Col.3, lines 46-48, col.17, lines 60-61, and col.18, lines 62-65 of Honel et al. each disclose that the use of isocyanate is optional. Thus, it is not required that the dispersant of Honel et al. contain urethane.

Applicant also argues that Honel et al. teach reaction that proceeds in the reverse fashion to the present invention.

However, col.3, lines 40-45 and col.11, lines 7-11 of Honel et al. disclose that the dispersant is produced by first reacting polyamine with cyclic carbonate followed by reaction

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with acid such as lactic acid then reaction with epoxide. This appears to be identical to the presently claimed reaction product.

Applicant argues that in the present invention ring opening occurs in the first step prior to attachment to epoxy while in Honel et al., the carbonate is attached to epoxy first followed by ring opening. But based on the above discussion, it is not clear where this is disclosed by Honel et al. That is, it appears that Honel et al., by first reacting polyamine with cyclic carbonate, does disclose ring opening first followed by reaction with epoxide. Clarification is requested.

Applicant argues that Klein et al. is not applicable against the present claims given that Klein et al. disclose binder not dispersant as required in the present claims.

Previously, in paragraph 9 of the office action mailed 4/23/03, examiner argued that although Klein et al. disclose binder and not dispersant given that Klein et al. disclose that the binder is identical to the dispersant presently claimed, that the binder of Klein et al. was capable of performing the recited purpose or intended use set forth in the present claims, namely, function as a dispersant.

Applicant argues that binder resins have a much larger size and very different structure than that of a dispersant. However, applicant has offered no evidence to support this position. Further, it is noted that "the arguments of counsel cannot take the place of evidence in the record", *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965). It is the examiner's position that the arguments provided by the applicant regarding Klein et al., namely, that the binder of Klein et al. is not the same as the presently claimed pigment dispersant, must be supported by a declaration or affidavit. As set forth in MPEP 716.02(g), "the reason for

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requiring evidence in a declaration or affidavit form is to obtain the assurances that any statements or representations made are correct, as provided by 35 U.S.C. 24 and 18 U.S.C. 1001".

Applicant also argues that Klein et al. disclose first reacting amine with epoxy followed by reaction with another epoxy while the present claims require first reacting amine with cyclic carbonate followed by reaction with epoxy.

However, as set forth in col.2, lines 6-11 of Klein et al., the epoxy used in the initial reaction of Klein et al. includes "aromatic epoxy resins" which are epoxy derivatives in which some or all of the epoxide groups of the aromatic polydiglycidyl ethers containing epoxide groups have been converted into 5-membered cyclic carbonate groups. Thus, the first reaction of Klein et al. does involve reaction of amine with carbonate as required in the present claims.

Applicant argues that the structure of the polymer of Klein et al. is not the same as that presently claimed. However, the present claims only require reacting amine with alkylene carbonate followed by reaction with acid followed by reaction with epoxy. Given that Klein et al. do disclose first reacting amine with carbonate as discussed above followed by reaction with acid and then epoxy, it would appear that Klein et al. meet the requirements of the present claims.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

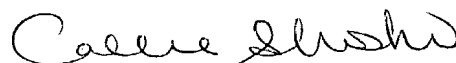
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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 571-272-1123. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Callie E. Shosho  
Primary Examiner  
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